REMARKS

The Office Action of July 2, 2007 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

Claims 19, 21-22, and 24-31 were pending prior to the instant amendment, of which claims 24, 25, 27 and 28 have been withdrawn. By this amendment, claims 19 and 26 are amended and claims 29-30 are withdrawn. Consequently, claims 19, 21-22, and 24-31 are currently pending in the instant application, of which claims 24, 25, and 27-30 are withdrawn.

Claim Objection

Claim 29 was objected to under 37 CFR 1.75(c). Claim 29 has been withdrawn along with claim 30. Thus the claims are believed to be in compliance.

Claim Rejection – 35 USC§102(b)

Claims 19, 21-22, and 26 were rejected under 35 U.S.C. §102(b) as being anticipated by Shuang. Shuang, however, fails to render the claimed invention unpatentable. Each of the independent claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, independent claim 19 recites a combination that includes, among other things:

> "forming the organic compound layer by co-depositing a metal alkoxide and an organic compound including a proton-donating functional group and a functional group having a non-covalent electron pair over the anode or the cathode . . ."

Independent claim 26 recites yet another combination that includes, *inter alia*,

> "forming the organic compound layer by co-depositing an organic compound represented by a following general formula (3) and a metal alkoxide over the anode or the cathode . . ."

At the very least, Shuang fails to disclose or suggest any of these exemplary features recited in the independent claims 1 and 66.

To establish anticipation under 35 U.S.C. § 102(b), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or "necessarily present" in a single prior art reference, such as within the four corners of the Shuang reference. *See* M.P.E.P.§ 2131(7th ed. 1998); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). To support a conclusion of anticipation, the Examiner must specifically identify "substantial evidence" setting forth why and how the single prior art reference anticipates each and every feature recited in the claims. *See In re Mullin*, 481 F.2d 1333, 1336-37 (CCPA 1973) (An Examiner's bare assertion that claims were obviously anticipated by a reference did not inform the Applicant as to why the claims lacked novelty); *Dickinson v. Zurko*, 527, U.S. 150 (1999) (The U.S. Patent Office's findings of fact must be reviewed by the substantial evidence standard).

Viewed against this backdrop, each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record. See In re Lee, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less to 'haze of so-called expertise' acquire insulation from accountability." Id. To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b). In this case, however, the Examiner cannot satisfy his

burden of demonstrating how Shuang, taken alone or in combination with any other prior art reference, can either render obvious each and every one of the limitations present in independent claims 1 and 26 as required by the Manual of Patent Examining Procedure ("MPEP") and Federal Circuit jurisprudence.

Shuang relates to an organic thin film electroluminescent (EL) device. The Examiner purports that Shuang "teaches that the metal salt can be metal alkoxide (1st full paragraph of pg. 11)." However, upon further review of Shuang, a disclosure of metal alkoxide, as recited by Applicants' claims, cannot be found in Shuang. Shuang does disclose "oxide of alkaline metals" and "oxide of alkaline earth metals", however, this description fails to disclose "metal alkoxide" as claimed.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claims are not found either expressly or inherently described as required by the M.P.E.P., Shuang cannot be said to anticipate the invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 21-22 depends from independent claim 19 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 19.

In addition, each of the dependent claims also recite combinations that are separately patentable.

Claim Rejection – 35 USC§103(a)

Claims 30-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shuang in view of Kido et al. Claims 19, 21-22, 26, and 30-31 were rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Heuer et al. in view of WO 00/32719 (hereafter '719). Claims 19, 21-22, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 40-9328679 (hereafter '679) in view of '719. Each of the aforementioned references, however, fail to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways.

For example, as mentioned above, amended independent claim 19 recites the co-deposition of an organic compound and a metal alkoxide. Independent claim 26 similarly recites metal alkoxide over the anode or the cathode. Shuang fails to disclose metal alkoxide as recited by Applicants' claims. Kido et al. does not cure the deficiencies of Shuang since it does not disclose or fairly suggest metal alkoxide. Heuer and '719 also fail to disclose the use of a metal alkoxide. By similar reasoning '679 in view of '719 lack a disclose or fair suggestion of the use of a metal alkoxide. Thus none of the combination of references can result in the invention as claimed.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Shuang, Kido et al., Heuer et al., '719, or '679, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 19 and 26. Hence, withdrawal of the rejection is respectfully requested.

It is noted that dependent claim 30 has been withdrawn.

Claim 21-22 and 31 depend from independent claim 19 and is patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 19.

In addition, each of the dependent claims also recite combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statue, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent agent at (202) 585-8316.

Respectfully submitted,

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